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In re Application of :
Martin, et al. :
Application No.: 10/506,721 :
PCT No.: PCT/US03/06793 :
Int. Filing Date: 04 March 2003 :
Priority Date: 07 March 2002 : RESPONSE
Attorney's Docket No.: 980049.402USPC :
For: QUINAZOLINONE MODULATORS OF :
NUCLEAR RECEPTORS :

This is in response to applicant's "PETITION FOR RECONSIDERATION," filed 16 December 2005. Applicant urges that the extra claim fees were charged in error.

BACKGROUND

On 04 March 2003, applicants filed international application PCT/US03/06793 which claimed priority to a United States provisional application which was filed 07 March 2002. A copy of the international application was communicated from the International Bureau on 18 September 2003. Accordingly, the thirty-month period for paying the basic national fee in the national stage in the United States expires at midnight on 07 September 2004.

On 07 September 2004, applicant filed a transmittal letter including, *inter alia*, a check for \$525 which included the basic national fee of \$460 and the \$65 fee for providing the oath/declaration after 30 months from the earliest priority date, as well as authorization to charge applicant's deposit account #19-1090 any additional fees that may be required. These papers were assigned U.S. application number 10/506,721.

On 19 January 2005, the United States Patent and Trademark Office charged applicant's deposit account an additional \$11,070 and \$145 for additional claim fees.

On 22 March 2005, applicant filed a request for refund indicating that the fees charged on 19 January 2005 were charged in error.

On 10 May 2005, a decision was mailed to applicant indicating that the fees were not charged in error, and that a subsequently filed amendment decreasing the number of claims will not entitle applicant to a refund.

On 10 December 2005, applicant filed the current petition stating that the amount in question was erroneously charged.

DISCUSSION

In the current petition, applicant's state, "Contrary to the conclusion in the Decision, Applicant's did not authorize payment of any excess claim fees in the accompanying transmittal letter. Applicant's submit that the payment of excess claim fees was not required when the above-identified application was actually filed in the PCT branch (on September 7, 2004). The only required fee at the time the application was actually filed in the PCT branch was, and still is, the basic national filing fee (see 37 CFR 1.495 (July 1, 2004) which explicitly states that in order to avoid the abandonment of an international application upon entering the U.S. national phase, the applicant must furnish to the USPTO a copy of the international application and the basic national filing fee)."

35 U.S.C. 41 states, in part:

(a) The Director shall charge the following fees:

(10) Basic national fee for an international application where the Patent and Trademark Office was the International Searching Authority but not the International Preliminary Examining Authority, \$690.

(11) Basic national fee for an international application where the Patent and Trademark Office was neither the International Searching Authority nor the International Preliminary Examining Authority, \$970.

(12) Basic national fee for an international application where the international preliminary examination has been paid to the Patent and Trademark Office, and the international preliminary examination report states that the provisions of Article 33 (2), (3), and (4) of the Patent Cooperation Treaty have been satisfied for all claims in the application entering the national stage, \$96.

(13) For filing or later presentation of each independent claim in the national stage of an international application in excess of 3, \$78.

(14) For filing or later presentation of each claim (whether independent or dependent) in a national stage of an international application in excess of 20, \$18.

(15) For each national stage of an international application containing a multiple dependent claim, \$260.

For the purpose of computing fees, a multiple dependent claim as referred to in section 112 of this title or any claim depending therefrom shall be considered as separate dependent claims in accordance with the number of claims to which reference is made. Errors in payment of the

additional fees may be rectified in accordance with regulations of the Director.

According to this statute, the extra claim fees are due on filing. Therefore, a general authorization to charge the required fees, gives the USPTO the authorization to charge the extra claim fees.

Applicant also states that 37 CFR 1.492 explicitly states that if additional fees are not paid on the presentation of the claims for which additional claims are due, these fees can be paid before the expiration of the time period set for response in any notice of fee deficiency. Although this is a true statement, this does not apply to applicant's situation since the fees were paid on filing of the application. As indicated in the decision mailed 10 May 2005, the transmittal letter (Form PTO-1390) included a general authorization to charge "any additional fees that may be required." Extra claims fees are required for claims presented in excess of 20. See MPEP 607. Contrary to Petitioner's assertion, the general deposit account authorization provided in Form PTO-1390 was not limited to "fees required in order to obtain a filing date for the application."¹

MPEP 189301(c) states, in part:

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that cancels claims and/or eliminates multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492(b)-(c) and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492(d). A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid. See MPEP § 607 and § 608.

MPEP 509.01 states, in part:

Many applications contain broad language authorizing any additional fees which might have been due to be charged to a deposit account. The U.S. Patent and Trademark Office will interpret such broad authorizations to include authorization to charge to a deposit account fees set forth in 37 CFR 1.16, and 1.17. Fees under 37 CFR 1.19, 1.20, and 1.21 will not be charged as a result of a general authorization under 37 CFR 1.25. Effective November 7, 2000, fees under 37 CFR 1.18 will not be charged as a result of a preauthorization of issue fee payment.

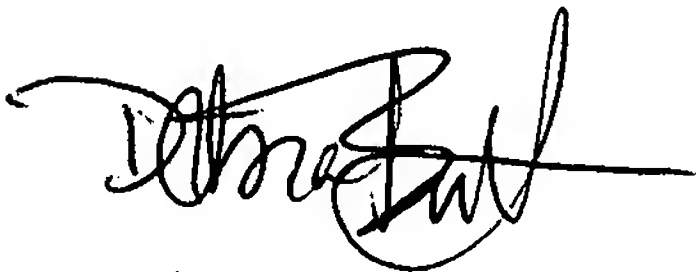
¹ Moreover, since the actual filing date of a US national stage application is its international filing date, (see 35 U.S.C. 363), a deposit account authorization limited to charging fees necessary to obtain a filing date would have no practical benefit.

With respect to the fact that applicant amended the application to reduce the number of claims on 21 March 2005, this does not entitle applicant to a refund of the originally paid claim fees. However, applicant is entitled to a refund of the later paid fees of \$3,050.

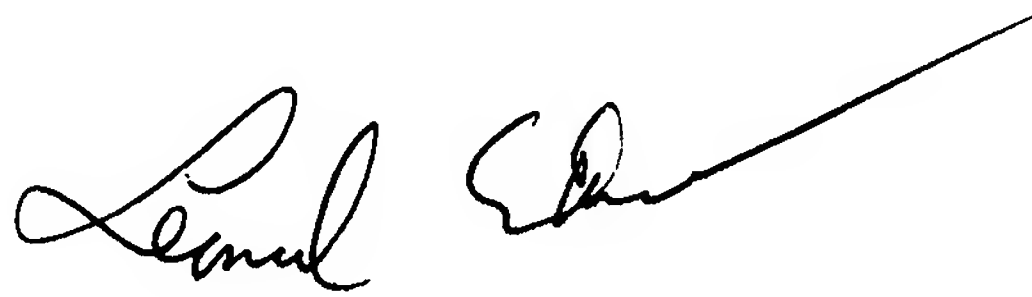
CONCLUSION

For the above reasons, the request for refund is **DISMISSED without prejudice.**

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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